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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,239	07/01/2003	Eric Kuo	018563-006700US	3324

46718 7590 01/25/2006

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/612,239	KUO, ERIC	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-21 and 27-36 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/29/03 5/4/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicant's election of the Group I invention, claims 1-21 and 27-36, in the communication received November 21, 2005 is acknowledge. The election was made without traverse. All non-elected claims have been canceled by the amendment received November 21, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695). Chishti teaches a plurality of appliances, Fig. 7, that are marked to designate an order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia. Wong teaches that it is known to used non-numeric indicia, color, to indicate order, column 2, lines 41-53. It would be obvious to one of ordinary skill in the art to modify Chishti to include the type of indicia shown by Wong in order to make use of known indicia to best communicate the desired order. As to claims 7 and 8, the type of color used is an obvious matter of choice in the type of indicia used to one of ordinary skill in the art. As to claim 9, Chishti teaches including the appliances in marked containers, column 15, lines 1-5.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) as applied to claim 2 above, and further in view of Rohlcke et al (5326259). The above combination does not show using a notch as indicia. Rohlcke teaches that a notch may be used as an alternative indicia, column 1, lines 21-24. It would be obvious to one of ordinary skill in the art to modify the above combination to include a notch as shown by Rohlcke in order to make use of known alternative indicia.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) as applied to claim 1 above, and further in view of Martin (6884071). The above combination does not show using a bar code as indicia. Martin teaches that a bar code may be used as an alternative indicia, column 7, lines 24-27. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bar code as shown by Martin in order to make use of known alternative indicia.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Wong et al (6206695) and Martin (6884071) as applied to claim 10 above, and further in view of Morris et al (5923001). The above combination does not show using a radio frequency tag. Morris shows using radio frequency tags to identify items. It would be obvious to one of ordinary skill in the art to modify the above combination to include a radio frequency tag as shown by Morris in order to make use of known ways of using and reading indicia to best communicate the desired message.

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Braverman (3780856). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the packages in a continuous chain. Braverman teaches providing packages in a continuous chain 10 in the order of use. It would be obvious to one of ordinary skill in the art to modify Chishti to include indicating order by providing packages in a continuous chain as shown by Braverman in order to make use of known ways of solving the problem of providing packages and indicating the order of use.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klein (4038753). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show providing the appliances on a framework. Klein teaches packaging dental appliances 18 by providing them on a framework 16. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing packages on a framework as shown by Klein in order to make use of known ways of solving the problem of providing dental appliances. Chishti teaches indicating the order of use. To supply the appliances in the order of use on the frame would have been obvious to one of ordinary skill in the art to make it easy for a user to follow the desired order.

Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Klatt (2003/0136698). Chishti teaches providing packages and indicating

Art Unit: 3732

their order of use, column 15, lines 1-5. Chishti does not show providing the appliances in a package in order of use. Klatt teaches providing items in a package 1 in the order of use, [0006]. It would be obvious to one of ordinary skill in the art to modify Chishti to include providing items in a package in their order of use as shown by Klatt in order to make use of known ways of solving the problem of providing package articles and indicating the order of use.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Baggett (4811845). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show using non-numeric indicia on the packages. Baggett teaches marking packages with non-numeric indicia. It would be obvious to one of ordinary skill in the art to modify Chishti to include using non-numeric indicia as shown by Baggett in order to make use of known types of indicia for communicating information on order.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Seidl (DE 3925088). Chishti teaches providing packages and indicating their order of use with numbers, column 15, lines 1-5. Chishti does not show providing additional marks on the numbers. Seidl teaches providing additional marks 4, Fig. 2, on numbers. It would be obvious to one of ordinary skill in the art to modify Chishti to include using indicia that includes numbers with additional marks as shown by Seidl in order to make use of known forms of indicia to communicate information.

Claims 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Fuller. Chishti teaches providing packages and indicating their order of use with numbers, column 15, lines 1-5. Chishti does not show removed numbers. Fuller teaches using removed numbers 6, Fig. 2, as indicia. It would be obvious to one of ordinary skill in the art to modify Chishti to include using removed numbers as shown by Fuller in order to make use of known indicia for communicating desired information.

Claims 30 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al (5975893) in view of Morrish et al (4726970). Chishti teaches providing packages and indicating their order of use, column 15, lines 1-5. Chishti does not show using shaped indicia. Morrish teaches using shaped indicia 35, Fig. 4, on packages 14. It would be obvious to one of ordinary skill in the art to modify Chishti to include the use of shaped indicia as shown by Morrish in order to make use of known indicia for communicating desired information.

Drawings

The drawings filed July 13, 2005 have been found to be acceptable by the examiner.

Allowable Subject Matter


Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
January 13, 2006